

**REMARKS**

In view of the above amendments and the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 1-14, 16, 25-34 and 37, the only claims pending and currently under examination in this application.

Claims 1 and 25 have been amended change the term "using" to "reading" in the preamble, support for this limitation being found at page 11, line 5. Claims 1, 25 and 37 have also been amended to incorporate the limitation of previously pending Claim 15, and Claim 15 has correspondingly been canceled. Finally, Claims 7 and 29 have been amended to clarify the wording of the claim by changing "data" to "results". As the above amendment introduces no new matter to the application, its entry by the Examiner is respectfully requested.

**Rejection of Claims 1-16, 25-34 and 37 under 35 U.S.C. § 112, second paragraph**

Claims 1-16, 25-34 and 37 have have been rejected under 35 U.S.C. § 112, 2<sup>nd</sup> ¶ for a number of different reasons, each of which is addressed separately below.

With respect to the issue reagarding the phrase "method of using" in the preamble of Claims 1 and 25, it is believed that this issue has been overcome by the above amendment to Claims 1 and 25 in which "using" has been changed to "reading."

With respect to the phrase "processing each region of each set according to a corresponding rountine for that set," appearing in Claims 1, 25 and 37, it is believed that this issue has been addressed by the above amendments to these claims.

With respect to the phrase "saving displayed shapes in a first file and at least some of the processed results in a second file," it is believed that this issue has been addressed by the above amendments to these claims.

With respect to Claims 1 and 25 and the phrase "at least some of," it is believed that this issue has been addressed by the above amendments to these claims.

With respect to Claims 1 and 25 and the phrase "methods of using an addressable array," it is believed that this issue has been addressed by the above amendments to these claims changing the term "using" to "reading."

With respect to Claims 7 and 29, it is believed that this issue has been addressed by the above amendments to these claims.

With respect to Claim 8, it is submitted that the objected to phrase is clear in view of the specification at page 12, lines 19 ff.

With respect to Claims 9 and 30, it is submitted that the objected to phrase is clear in view of the specification at page 12, lines 30 ff.

As such, it is submitted that this rejection may be withdrawn.

**Rejection of Claims 1-4, 25, 26 and 37 under 35 U.S.C. § 102(e) over Yakhini**

Claims 1-4, 25, 26 and 37 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Yakhini. As the limitation of original Claim 15 has been incorporated into each of these claims by amendment of independent Claims 1, 25 and 37, and Claim 15 was not included in this rejection, this rejection may be withdrawn.

**Rejection of Claims 5, 11-16, 27, 28 and 31-34 under 35 U.S.C. § 103(a) over Yaknini in view of Zhou**

Claims 5, 11-16, 27, 28 and 31-34 have next been rejected under 35 U.S.C. § 103(a) as being obvious over Yakhini in view of Zhou.

35 USC § 103(c), MPEP § 706.02(l)(1) states:

Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) is now disqualified as prior art against the claimed invention if that subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. This change to 35 U.S.C. 103(c) applies to all utility, design and plant patent applications filed on or after November 29, 1999, including continuing applications filed under 37 CFR 1.53(b), continued prosecution application filed under 37 CFR 1.53(d), and reissues."

As such the changes to 35 U.S.C. §103 apply to all utility patent applications filed on or after November 29, 1999. The instant application was filed on January 31, 2001, which is after November 29, 1999, §103(c) as set out above applies to the instant application. Thus, if the Yakhini patent and the instant application were owned by the same person or subject to an obligation of assignment to the same person, at the time the instant application was made, the Yakhini patent is not available as prior art under 35 USC §103.

This is indeed the case. The invention claimed in the instant patent application was subject to an obligation of assignment to Agilent Technologies. An assignment executed by the inventor Herbert F. Cattell was recorded on January 16, 2003 (Reel/Frame 013366/0037).

The Yakhini patent cited as art was owned by Agilent Technologies at the time the claimed invention in that patent was made, as evidenced by an assignment by the listed inventors to Agilent Technologies, recorded on January 8, 2001(Reel/Frame 011225/0097) (copy enclosed).

Thus, as stated in §103(c), the subject matter of the cited Yakhini patent and the claimed invention were, at the time the invention was made, both owned by Agilent or both under an obligation of assignment to Agilent. As such the Yakhini patent shall not preclude patentability under §103.

Therefore, the Yakhini patent is not available as prior art against the claimed invention of the present application. The claims thus cannot be rejected by a combination that relies upon the disclosure of Yakhini.

Accordingly, the rejection of Claims 5, 11-16, 27, 28 and 31-34 under 35 U.S.C. § 103(a) as being obvious over Yakhini in view of Zhou may be withdrawn.

**CONCLUSION**

The applicant respectfully submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone Gordon Stewart at 650 485 2386. The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16 and 1.17 which may be required by this paper, or to credit any overpayment, to Deposit Account No. 50-1078.

Respectfully submitted,

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